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09/981,525

10/16/2001

Fred Burbank

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05/28/2008

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EXAMINER

FOREMAN, JONATHAN M

ART UNIT

PAPER NUMBER

3736

MAIL DATE

DELIVERY MODE

05/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--|---------------------------------------|--|
| Office Action Summary | Application No. 09/981,525 | Applicant(s) BURBANK ET AL. | |
| | Examiner JONATHAN ML FOREMAN | Art Unit 3736 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-46, 48 and 49 is/are rejected.
- 7) ☒ Claim(s) 47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 35 – 43 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35 recites the limitation "the inner lumen" in line 13. There is insufficient antecedent basis for this limitation in the claim. Previously, a "main lumen" is set forth.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 44 – 46 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,810,806 to Ritchart et al.

In regard to claims 44 – 46 and 49, Ritchart et al. an elongated probe member (36) having a proximal end, a distal end, a tissue penetrating distal tip (37) at the distal end, a longitudinal axis extending between the proximal and distal ends, a tubular sidewall, a cut out (38) in the sidewall proximal to the distal end and an inner lumen extending within at least a portion of the elongated probe member and in fluid communication with the cut out; an electrically conducting cutting wire

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that is slidably and rotatably disposed in the passageway, which has a distal end and a cutting loop (20) at the distal end that is configured to rotate (Figure 3) from a position within the probe member out of the cut out in the sidewall to a position exterior to the probe member in a plane transversing the longitudinal axis of the probe member (Col. 8, lines 55 – 57; Col. 7, lines 20 – 23; Col. 9, lines 48 – 53), to move longitudinally in a direction generally parallel to the longitudinal axis (Col. 9, lines 32 – 36) exterior to the probe member and to rotate from a position exterior to the elongated probe member into the probe member through the cut out in the sidewall in a plane transversing the longitudinal axis while subjected to high frequency electrical power (Col. 7, line 43 - Col.8, line 15). The cutting wire is electrically connected to a source of RF electrical energy (Col 7, lines 51 – 54). The cutting wire is formed in part of a material selected from the group consisting of stainless steel, tungsten, platinum, and nickel-titanium alloy. A vacuum source is in fluid communication with the inner lumen (Col. 9, lines 9 – 11).

Response to Arguments

5. Applicant's arguments filed 9/20/07 have been fully considered but they are not persuasive. Applicant asserts that the Examiner is in error regarding the rejection of claims 35 - 43 and 48 under 35 U.S.C. 112, second paragraph in that "main lumen" refers to the outer cannula. However, claim 35, lines 1 - 4 state:

"an inner cannula having a proximal end, a distal end, a longitudinal axis extending between said proximal and distal ends, a tubular sidewall, a cut out in the sidewall proximal to the distal end and a ***main lumen*** extending within at least a portion of the inner cannula to the cut out in the sidewall;"

6. Applicant asserts that Ritchart et al. fail to disclose the cutting loop traveling parallel to the longitudinal axis of the probe member outside of the probe member and then rotating back into the

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probe member through the side opening while the loop is subjected to high frequency electrical power. However, the Examiner disagrees. Ritchart et al. discloses the loop being configured to rotate (Figure 3). A user can selectively apply high frequency electrical power to the loop (Col. 7, line 43 – Col. 8, line 15). Because the loop is carried on a member (46) that is slidably received within the elongated probe member (36) it is capable of moving *generally* parallel to the longitudinal axis of the probe member.

Allowable Subject Matter

7. Claims 35 – 43 and 48 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. Claim 47 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN ML FOREMAN whose telephone number is (571)272-4724.

The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charles A. Marmor, II/
Supervisory Patent Examiner
Art Unit 3735

/J. M. F./
Examiner, Art Unit 3736